<u>REMARKS</u>

Claims 1-3, 5, 6, 15, and 16 remain pending in this application for which applicants seek reconsideration.

<u>Art Rejection</u>

Claims 1-3, 6, 15, and 16 remain rejected under 35 U.S.C. § 103(a) as unpatentable over Misawa (USP 6,771,382) in view of Kim (USP 6,268,937). Claim 5 remains rejected under § 103(a) as unpatentable over Misawa in view of Kim and Morigami (USP 6,057,934).

First, in the last reply, applicant explained that Misawa does not disclose or teach a controller that controls the first or second producer and the processor to convert the input image data either with or without white data added when the user instructs through the selector to select either the facsimile transmission or the email transmission. In this respect, applicants argued that the combination would not have taught selecting with the selector (Misawa, Fig. 6, S57 or S77) to an email transmission or a fax transmission changes the manner in which the processor processes data since Misawa fails to disclose converting the image data depending on whether a fax transmission or an email transmission is selected.

In response, the examiner argues that applicants' argument is misplaced because applicants only address individual references rather than the combination. According to the examiner, as Kim would have taught adding white data only when the facsimile transmission needs it, the examiner argues that the combination would have taught changing the manner in which the processor processes data depending on what mode the user selects the selector.

Applicants disagree with the examiner's assessment because the examiner's premise behind the art rejection is based on faulty understanding of what the combined references would have taught. As previously explained, the combination would have taught adding white data for all image data when white data is needed regardless of how the image data is to be transmitted. See below.

Second, applicants also explained that Kim would have taught adding white data to all image data (not fitting a standard size or is non-standard size) that have been scanned regardless of how the scanned image data is to be transmitted.

In response, the examiner argues that Kim teaches adding white data as needed only applies when using a facsimile transmission. According to the examiner, since Kim is directed only to a facsimile transmission, the examiner argues that applicants' argument regarding adding white data to an email transmission is misplaced. According to the examiner, there is no need to add white data to an email data as it is not regularly formatted to a paper size and

printed as in the case of facsimile data. Applicants disagree because white data is also normally added to image data for email transmission in contrast to the examiner's assertion.

While there is no steadfast rule that a facsimile or email transmission should add or not add white data as required to conform the image data to a standard size, white data is normally added to the email data (again not because of any protocol requiring or not requiring it) for sake of conforming the facsimile and email to be alike when viewed/printed. Indeed, Toyoda (USP 5,881,233 filed as an IDS on 29 December 2008) discloses a facsimile apparatus that transmits image data input from a common input source, like Misawa, either to the facsimile or email mode based on the user selection. See Fig. 25. Misawa does not explicitly disclose how the scanned image data is formed. But Toyoda does. Specifically, Toyoda has a data compressor/expander 8A that encodes the binary image data converted by the scanner 6 the same way regardless of how the image data is to be sent:

> The step S94 activates the scanner 6 so that an image of the surface of a document sheet in the scanner 6 is converted by the scanner 6 into corresponding binary image data (corresponding bi-level image data). A step S95A following the step S94 transfers the binary image data from the scanner 6 to the data compressor/expander 8A. Then, the step S95A activates the data compressor/expander 8A so that the binary image data is compressed by the device 8 into compression-resultant image data of a given facsimile format. [¶ spanning columns 20-21].

> A step S95B subsequent to the step S95A transfers the compression-resultant image data of the facsimile format from the data compressor/expander 8A to the modem 18. [Column 21, lines 7-9].

> The step S97 activates the scanner 6 so that an image of the surface of a document sheet in the scanner 6 is converted by the scanner 6 into corresponding binary image data (corresponding bi-level image data). A step S98A following the step S97 transfers the binary image data from the scanner 6 to the data compressor/expander 8A. Then, the step S98A activates the data compressor/expander 8A **so that the binary image data is compressed by the device 8 into compression-resultant image data of a given facsimile format**. [Column 21, lines 29-37]

A step S98B following the step S98A transfers the compression-resultant image data of the facsimile format from the storage unit 4 to the format converter 5. The step S98B activates the format converter 5 so that the compression-resultant image data of the facsimile format is converted by the device 5 into corresponding image data of the e-mail format. [Column 21, lines 48-54].

Misawa also would have used the same image data in both the facsimile mode and in the electronic mail mode as evidenced by Toyoda. In other words, if a common input source is used for both the facsimile and email transmissions, the image data is formed the same way so that it can be sent either way. Where the facsimile transmission requires adding white data to change the size of the input image data to a standardized size, it is logical to send the same data, with the added white data, using the email transmission to produce the same image data regardless of whether the image data is transmitted through the facsimile or the email, as evidenced by Toyoda, which is how Misawa would have transmitted the image file.

Since Misawa shares a common image input for both the facsimile transmission and email transmission functions, per the Kim's teachings of adding white data to image data, the combination would have taught using the same image data (i.e., added white data to the image data) for the email transmission, as evidenced by Toyoda. Thus, in contrast to the examiner's understanding, Kim would have taught adding white data to all images (not fitting a standard size or is non-standard size) that have been scanned regardless of how the scanned data is transmitted. Accordingly, Kim still would not have alleviated Misawa's shortcomings.

The claimed invention was devised to solve different problems not recognized by prior art, namely adding white data to email data undesirably displays the region of the added white data. The claimed invention aims to add the white data to the image data transmitted through the facsimile but not to the image data transmitted through the electronic mail. The combination urged by the examiner would not have taught this feature.

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Request for Interview

Applicants seek an interview in due course, before the examiner issues a next Office Action. The undersigned will contact the examiner to schedule an interview in due course. The examiner, however, is urged to contact the undersigned if the examiner intends to act on this case before an interview is scheduled.

Conclusion

Applicants submit that the pending claims patentably distinguish over the applied references and are in condition for allowance. Should the examiner have any issues concerning this reply or any other outstanding issues remaining in this application, applicants urge the examiner to contact the undersigned to expedite prosecution.

Respectfully submitted,

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